

### REMARKS

This responds to the Final Office Action mailed on November 12, 2008.

Claims 1, 2, 7 and 15 are amended; as a result, claims 1-15 are now pending in this application.

#### §103 Rejection of the Claims

Claims 1-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak et al. (U.S. Publication No. 2003/0097655; hereinafter "Novak") in view of Florin et al. (U.S. Patent No. 5,621,456; hereinafter "Florin").

Applicant respectfully submits that the rejection of the aforementioned claims under 35 U.S.C. § 103 is defective for the reason that prior art references, when combined, do not teach or suggest all of the claim limitations of the independent claims of the present application.

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. §2142. In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*<sup>1</sup>, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*<sup>2</sup> was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined."<sup>3</sup>

When claim elements are found in more than one prior art reference, the fact finder must determine "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims." *In re Kahn*<sup>4</sup>. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of*

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<sup>1</sup> 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

<sup>2</sup> 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

<sup>3</sup> The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

<sup>4</sup> 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

*Kansas City*<sup>5</sup>. Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*<sup>6</sup>. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*<sup>7</sup>. Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*<sup>8</sup>.

A rejection of obviousness requires satisfaction of the *Graham* factual inquiries,<sup>9</sup> which require:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.<sup>10</sup>

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<sup>5</sup> 383 U.S. 1 at 467.

<sup>6</sup> 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>7</sup> 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

<sup>8</sup> 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

<sup>9</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), remains the basis for every decision regarding obviousness. As noted by Commissioner for Patents John Doll for the USPTO "[t]hat is, patent examiners will continue to consider (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) objective evidence relevant to the issue of obviousness.

<sup>10</sup> MPEP § 2143. See also *KSR*, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675

Applicant respectfully submits that the applied references do not satisfy the Graham inquiries, as they fail to include each element claimed; and further, Applicant disagrees with the Examiner's characterization of the applied references as teaching the claimed inventive subject matter.

Although the Applicant believes that the original pending claims defined Applicant's inventive subject matter over the applied references, Applicant has amended independent claims 1, 7 and 15 to further clarify, in part, that the transaction token incorporates a "first code uniquely identifying a subscriber secure device," and the transaction token is generated "in co-operation with the client secure device."

With respect to independent claim 1, which recites *a system for effecting a transaction, including*

*a head-end,*

*a communications network,*

*a subscriber secure device,*

*a receiver, capable of*

*receiving digital information, including content data from the head-end through the network, and of making the content data available to a user on a display device, which receiver further includes an interface to the subscriber secure device, wherein the receiver is programmed to make a first code available on the display device, the first code uniquely identifying the subscriber secure device,*

*a client secure device, and*

*a terminal having a user interface for entering the first code, wherein the terminal is arranged to create a transaction token from the entered first code in co-operation with the client secure device, wherein the terminal includes*

*an interface to the client secure device.*

The applied references do not satisfy the Graham inquiry in that, at least, the applied references do not include each element claimed. Both Novak and Florin teach systems including a television display and a set top box, the set top box having access to a subscriber secure device.

These references do not teach a *client secure device* and a *terminal*, as recited in Applicant's claims, in which "no return channel is necessary from the receiver to the head-end. A transaction is effectively tied to a subscriber secure device, but the subscriber secure device is not actively needed to generate the token. Indeed, a user of a client secure device and terminal can order a product for someone else. This other person is identified by the first code, which is tied to the subscriber secure device."<sup>11</sup> In other words, the *client secure device* is distinct from the *subscriber secure device*.

The technical effect of the distinguishing features of Applicant's claims is that a transaction is effectively tied to a *subscriber secure device* (e.g. smartcard) in a *receiver* (e.g. set-top box), but the *subscriber secure device* is not actively used to generate the *transaction token*. Instead the *transaction token* is generated by a terminal *in co-operation with a client secure device* (e.g. SIM-card), whereby the *first code identifying the subscriber secure device* is used by the *terminal* and *client secure device* to create the *transaction token*. As a result, the user of the *terminal* and the owner of the *subscriber secure device* can be different persons.

With respect to claim 7, which recites a *terminal for creating a transaction token*, including

*an interface to a client secure device, and arranged to create a transaction token  
incorporating a first code, the first code uniquely identifying a subscriber secure  
device, and*

*a user interface for entering the first code,*

*wherein the terminal is arranged to create the transaction token from the entered first code in  
co-operation with the client secure device,*

the applied references do not teach such a *terminal*. The arguments provided above with respect to claim 1 are also applicable to claim 7, and claims depending thereon. Similar argumentation is valid for claim 7, as well as claims depending on claims 1 and 7. Applicant respectfully submits the pending claims are patentable over the applied references. Therefore, Applicant respectfully requests reconsideration and allowance of the pending claims.

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<sup>11</sup> Applicant's specification, ¶[0015].

*Reservation of Rights*

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date February 11, 2009

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 11, 2009.

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